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10/061,675	02/01/2002	James G. Norman JR.	66475/31300	1732
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EXAMINER LE, LINH GIANG				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* JAMES G. NORMAN JR
9

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11 Appeal 2009-014343
12 Application 10/061,675
13 Technology Center 3600
14

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16 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
17 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
18 FETTING, *Administrative Patent Judge*.

19 DECISION ON APPEAL¹
20

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE²

James G. Norman Jr (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a non-final rejection of claims 1-30. Subsequent to the non-final rejection, claims 15-18 and 20-30 were cancelled. Claims 1-14 and 19 remain. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellant invented a way of directing users to health care information (Specification 1:6-7).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method of using a prescription pad to facilitate providing health care information to a patient, the prescription pad having a plurality of prescription sheets, the method comprising:

[1] performing a diagnostic procedure on a patient to identify an ailment of the patient;

[2] placing on at least one of the prescription sheets of the prescription pad

an address for an Internet web site,

² Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed December 3, 2007) and Reply Brief ("Reply Br.," filed May 12, 2008), and the Examiner's Answer ("Ans.," mailed March 13, 2008).

1 information about the ailment being accessible via
2 the Internet web site; and
3 [3] giving the one prescription sheet to the patient.
4

5 The Examiner relies upon the following prior art:

Lapsker	US 4,971,362	Nov. 20, 1990
Illiff	US 5,935,060	Aug. 10, 1999
McIlroy	US 5,953,704	Sep. 14, 1999
Norman, Jr	US 6,738,754 B1	May 18, 2004

6 Claim 8 stands rejected under 35 U.S.C. § 101 as claiming the same
7 subject matter as another U.S. Patent.³

8 Claims 1-5 and 11-13 stand rejected under 35 U.S.C. § 103(a) as
9 unpatentable over Lapsker and Illiff.

10 Claims 6-10, 14 and 19 stand rejected under 35 U.S.C. § 103(a) as
11 unpatentable over Lapsker, Illiff, and McIlroy.

12 ISSUES

13 The issue of double patenting hinges on whether claim 8 contains
14 identical subject matter as any of the claims in Norman. The issue of
15 obviousness hinges on whether it was predictable to use a prescription pad to
16 write down the address of a medical information web site and provide the
17 prescription so written to a patient, and whether such information is afforded
18 patentable weight.

³ Claims 15-18 and 20-30 have been cancelled in the Examiner Amendment mailed January 26, 2010.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Lapsker

01. Lapsker is directed to a prescription pad and ways of monitoring prescription fulfillment. Lapsker 1:6-10.
02. Lapsker describes a physician writing a prescription for an appropriate pharmaceutical on a prescription sheet and giving the prescription sheet to the patient. Lapsker 1:12-20.
03. Lapsker's prescription sheet bears a preprinted description of a pharmaceutical product. Lapsker 4:38-40.

Illiff

04. Illiff is directed to computerized medical diagnostic systems. Illiff 1:24-25.
05. Illiff describes allowing patients to consult the diagnostic system for information on their symptoms and diagnosis. Illiff 2:38-41.
06. Illiff's system is connected to the Internet for access. Illiff 4:1-4.

McIlroy

07. McIlroy is directed to a diagnostic health system. McIlroy
1:29-36.

08. McIlroy describes the Current Procedure Terminology (CPT)
code as a numeric procedure code that identifies procedures in
medical information systems. McIlroy 7:1-21.

ANALYSIS

*Claim 8 rejected under 35 U.S.C. § 101 as claiming the same subject matter
as another U.S. Patent.*

The Examiner rejected these claims under statutory double patenting, not
non-statutory double patenting. The Appellant argues that none of the
claims in issued U.S. Patent 6,738,754 contains subject matter identical to
that in claim 8. We agree with the Appellant.

The Examiner has not identified any particular claim that duplicates the
subject matter of claim 8, instead generally finding that a range of claims in
the present application contain identical subject matter as another range of
claim in the '754 patent. We find none that align with claim 8. For
example, each of the independent claims in the '754 patent recite storing
information, which claim 8 in the instant application does not. We are
persuaded the Examiner erred with respect to claim 8.

1 *Claims 1-5 and 11-13 rejected under 35 U.S.C. § 103(a) as unpatentable*
2 *over Lapsker and Illiff.*

3 The Examiner found that Lapsker described the conventional practice of
4 a physician performing a diagnostic procedure and placing a prescription on
5 a prescription pad and giving the prescription sheet to the patient. As the
6 only distinction between this and claim 1 is in the contents of the
7 prescription sheet, the Examiner found that Illiff described the web site for a
8 medical diagnostics system, which would require a web address to access.

9 The Examiner found it was predictable for a physician to write such an
10 address down for a patient inquiring about further information related to a
11 diagnosis. Ans. 4-5. *Also* FF 02. The Appellant argues that Lapsker does
12 not describe putting an internet address on the prescription sheet and Illiff
13 does not describe using a prescription pad. Appeal Br. 10-12. The
14 Examiner replied that the Appellant's arguments are attacking the references
15 separately, even though the rejection is based on the combined teachings of
16 the references.

17 We agree with the Examiner. Nonobviousness cannot be established by
18 attacking the references individually when the rejection is predicated upon a
19 combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d
20 1091, 1097 (Fed. Cir. 1986). One of ordinary skill would have found it
21 predictable for a physician to provide a web address where a patient could
22 find further information regarding a diagnosis, and a prescription pad is
23 readily available in a physician's office as a slip to write such an address on.

24 The Examiner also responded that the contents of the prescription pad
25 are non-functional descriptive material and afforded no patentable weight.

1 Ans. 17. The Appellant argued that the information relates to the
2 information about the aliment. Nevertheless, the web address is just written
3 data having no structural relation to the prescription pad. Nonfunctional
4 descriptive material cannot render nonobvious an invention that would have
5 otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).
6 *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive
7 material is not functionally related to the substrate, the descriptive material
8 will not distinguish the invention from the prior art in terms of patentability).

9 We note that the Appellant contended that there is no bar to reciting an
10 invention in terms of how it works or functions. Reply Br. 3. We agree with
11 this general principal, but find it is inapposite here, as the written material on
12 a prescription pad bears no functional relation to the remainder of the claim.

13 As to claim 2, reciting that the step of placing the address for the Internet
14 web site on at least one of the prescription sheets precedes the step of
15 performing the diagnostic procedure on the patient, the Examiner found that
16 Lapsker preprinted its prescription pads with pre-identified pharmaceuticals,
17 and that given that the web site in Illiff was similarly pre-identified, the web
18 address so written on a prescription pad by the combination of Lapsker and
19 Illiff would likewise, be preprinted. Ans. 5. *Also* FF 03. The Appellant
20 again argues the references separately. Ans. 12.

21 The remaining claims are argued based on the patentability of claim 1
22 and we find them unpersuasive as to the remaining claims as well.
23
24

*Claims 6-10, 14 and 19 rejected under 35 U.S.C. § 103(a) as unpatentable
over Lapsker, Illiff, and McIlroy.*

Claims 8 and 19 recite using an ICD or CPT code as an index for retrieving such information. The Examiner applied McIlroy to describe this limitation. *See* Ans. 8:cl. 6. *See also* FF 08. The Appellant again argues the references separately. Appeal Br. 16; Reply Br. 3-4. We agree with the Examiner that since CPT is a numeric code that identifies procedures of interest to a patient with a particular diagnosis, it would be predictable to have such a code be an index into a medical information system.

The remaining claims are argued on the basis of the arguments in support of claims 1, 8, and 19, and so are found equally unpersuasive as to those claims.

CONCLUSIONS OF LAW

Rejecting claim 8 under 35 U.S.C. § 101 as claiming the same subject matter as another U.S. Patent is in error.

Rejecting claims 1-5 and 11-13 under 35 U.S.C. § 103(a) as unpatentable over Lapsker and Illiff is not in error.

Rejecting claims 6-10, 14 and 19 under 35 U.S.C. § 103(a) as unpatentable over Lapsker, Illiff, and McIlroy is not in error.

DECISION

To summarize, our decision is as follows.

- The rejection of claim 8 under 35 U.S.C. § 101 as claiming the same subject matter as another U.S. Patent is not sustained.
- The rejection of claims 1-5 and 11-13 under 35 U.S.C. § 103(a) as unpatentable over Lapsker and Illiff is sustained.
- The rejection of claims 6-10, 14 and 19 under 35 U.S.C. § 103(a) as unpatentable over Lapsker, Illiff, and McIlroy is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

mev

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